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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/917,016

Applicant(s)

UDOM ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/26/01 &amp; 12/6/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: On page 4, line 10, "117" should read "116", line 11, "106" should read "111", and line 21, "116" should read "120". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9, 11-14, 16-19, 21-25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6515988 to Eldridge et al.

Regarding claims 1 and 13, Eldridge discloses a method and storage media for printing from a portable device, comprising the following steps: (a) upon a selection to print, displaying available printing options (see Fig. 2, column 4 lines 12-23, column 5 line 65-column 6 line 15, and column 7 lines 17-34, 44-54 and 58-61, reference shows

that a user can choose a "token", which contains a small amount of essential information pertaining to data, located in a remote server or computing system, which is to be retrieved, processed, and printed, and can select the method in which the data is to be executed, for example, printed, scanned, faxed, etc., further options relate to the number of copies to be printed and the like), including the following substep: (a.1) providing an option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device (see column 5 line 65-column 6 line 15, column 8 lines 14-26 and column 9 lines 24-49, reference shows that a "token" can be sent via a network to a computing system which can decode the "token", retrieve data located on a remote server, process the data, and print the data at a remote printer, all of which is analogous to the claim limitation), and, (b) upon selection of one of the available printing options, performing a print operation in accordance with the selection (see column 5 line 65-column 6 line 15, column 7 lines 26-34, and column 9 lines 24-49).

Regarding claims 8 and 19, Eldridge discloses a method and storage media for printing from a portable device, comprising the following steps: (a) upon a selection to print, displaying available printing options (see Fig. 2, column 4 lines 12-23, column 5 line 65-column 6 line 15, and column 7 lines 17-34, 44-54 and 58-61, reference shows that a user can choose a "token", which contains a small amount of essential information pertaining to data, located in a remote server or computing system, which is to be retrieved, processed, and printed, and can select the method in which the data is to be executed, for example, printed, scanned, faxed, etc., further options relate to the

number of copies to be printed and the like), including the following substep: (a.1) providing an option to use a template to provide standardized formatting to data to be printed (see column 7 lines 26-34, reference shows a user interface of a PDA capable of printing a type-in form to be filled in by the user which is analogous to a template and thus anticipates the claim limitation), and, (b) upon selection of one of the available printing options, performing a print operation in accordance with the selection (see column 5 line 65-column 6 line 15, column 7 lines 26-34, and column 9 lines 24-49).

Regarding claims 12 and 22, Eldridge discloses a method for printing from a portable device, comprising the following steps: (a) upon a selection to print, displaying available printing options (see Fig. 2, column 4 lines 12-23, column 5 line 65-column 6 line 15, and column 7 lines 17-34, 44-54 and 58-61, reference shows that a user can choose a "token", which contains a small amount of essential information pertaining to data, located in a remote server or computing system, which is to be retrieved, processed, and printed, and can select the method in which the data is to be executed, for example, printed, scanned, faxed, etc., further options relate to the number of copies to be printed and the like); including the following substep: (a.1) providing an option to print when the portable device is synchronized with a computing system (see column 5 lines 14-28 and 46-60, and column 5 line 65-column 6 line 15, reference shows that a portable device is capable of communicating directly with a particular computing device or output device which is analogous to the claim limitation), and, (b) upon selection of one of the available printing options, performing a print operation in accordance with the

selection (see column 5 line 65-column 6 line 15, column 7 lines 26-34, and column 9 lines 24-49).

Regarding claim 23, Eldridge discloses a portable device comprising: a display (see Fig. 2), and, a printing control entity within the portable device, the printing control entity upon recognition of a print selection, displaying available printing options, providing on the display an option to print remote data accessible at a location outside of the portable device by reference to the location outside of the portable device, and upon selection of one of the available printing options, performing a print operation in accordance with the selection (see column 5 line 46-column 6 line 15, column 7 line 17-column 8 line 26, and column 9 lines 24-49).

Regarding claim 25, Eldridge discloses a portable device comprising: a display (see Fig. 2), and, a printing control entity within the portable device, the printing control entity upon recognition of a print selection, displaying available printing options, providing an option to use a template to provide standardized formatting to data to be printed, and upon selection of one of the available printing options, performing a print operation in accordance with the selection (see column 5 line 46-column 6 line 15, column 7 line 17-column 8 line 26, and column 9 lines 24-49, reference shows a user interface of a PDA capable of printing a type-in form to be filled in by the user which is analogous to a template and thus anticipates the claim limitation).

Regarding claim 27, Eldridge discloses a portable device comprising: a display (see Fig. 2); and, a printing control entity within the portable device, the printing control entity upon recognition of a print selection, displaying available printing options,

providing an option to print when the portable device is synchronized with a computing system, and upon selection of one of the available printing options, performing a print operation in accordance with the selection (see column 5 line 46-column 6 line 15, column 7 line 17-column 8 line 26, and column 9 lines 24-49).

Regarding claims 2 and 9, Eldridge discloses the system discussed in claims 1 and 8, and further discloses wherein the portable device is a personal digital assistant (see Fig. 2, column 5 lines 23-28 and column 8 lines 62-66).

Regarding claims 3 and 14, Eldridge discloses the system discussed in claims 1 and 13, and further discloses (a.2) providing an option to use a template to provide standardized formatting to data to be printed (see column 7 lines 26-34, reference shows a user interface of a PDA capable of printing a type-in form to be filled in by the user which is analogous to a template and thus anticipates the claim limitation).

Regarding claims 5, 11, 16, and 21, Eldridge discloses the system discussed in claims 1, 8, 13, and 19, and further discloses (a.2) providing an option to print when the portable device is synchronized with a computing system (see column 5 lines 14-28 and 46-60, and column 5 line 65-column 6 line 15).

Regarding claims 6 and 17, Eldridge discloses the system discussed in claims 1 and 13, and further discloses (a.2) providing an option to print by using an internet service provider to send data to be printed to a printer (see column 4 line 64-column 5 line 3 and column 6 lines 48-53).

Regarding claims 7 and 18, Eldridge discloses the system discussed in claims 1 and 13, and further discloses (a.2) providing an option to print the remote data by using

an internet service provider to send the reference to the location outside the portable device to a computing system connected to a printer (see column 4 line 64-column 5 line 3 and column 9 lines 24-49).

Regarding claim 24, Eldridge discloses the system discussed in claim 23, and further discloses a print button which is pressed by a user to make the print selection (see Fig. 2, column 6 lines 1-10, column 7 lines 26-34, column 8 lines 29-36, and column 8 line 62-column 9 line 12).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10, 15, 20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge as applied to claims 1, 8, 13, 19, and 25 above, and further in view of U.S. Patent No. 6832351 to Batres.

Regarding claims 4 and 15, Eldridge discloses (a.2) providing an option to use a template to provide standardized formatting to data to be printed. (see column 7 lines 26-34).

Eldridge does not disclose expressly (a.3) upon selection of the option to use a template to provide standardized formatting to data to be printed, displaying a list of

available templates, wherein, upon selection of one from the list of available templates, the selected template is used in step (b) in performance of the print operation.

Batres discloses (a.3) upon selection of the option to use a template to provide standardized formatting to data to be printed, displaying a list of available templates, wherein, upon selection of one from the list of available templates, the selected template is used in step (b) in performance of the print operation (see column 7 lines 24-48 and 61-64).

Regarding claims 10 and 20, Eldridge does not disclose expressly (a.2) upon selection of the option to use a template to provide standardized formatting to data to be printed, displaying a list of available templates, wherein, upon selection of one from the list of available templates, the selected template is used in step (b) in performance of the print operation.

Batres discloses (a.2) upon selection of the option to use a template to provide standardized formatting to data to be printed, displaying a list of available templates, wherein, upon selection of one from the list of available templates, the selected template is used in step (b) in performance of the print operation (see column 7 lines 24-48 and 61-64).

Regarding claim 26, Eldridge does not disclose expressly wherein the printing control entity additionally, upon selection of the option to use a template to provide standardized formatting to data to be printed, displays a list of available templates, wherein, upon selection of one from the list of available templates, the selected template is used in performance of the print operation.

Batres discloses wherein the printing control entity additionally, upon selection of the option to use a template to provide standardized formatting to data to be printed, displays a list of available templates, wherein, upon selection of one from the list of available templates, the selected template is used in performance of the print operation (see column 7 lines 24-48 and 61-64).

Eldridge & Batres are combinable because they are from the same field of endeavor, manipulation of remote data to be printed.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the display and selection of a plurality of templates for which user data will be merged and printed as described by Batres with the system of Eldridge.

The suggestion/motivation for doing so would have been to provide a user with increased mobility and efficiency due to a plurality of templates available for the user to fill in to acquire the desired output form at the exact time it is desired (see column 3 lines 30-40 of Batres).

Therefore, it would have been obvious to combine Batres with Eldridge to obtain the invention as specified in claims 4, 10, 15, 20, and 26.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent numbers

5862321 (Lamming et al.), 6717686 (Farros et al.), 6859832 (Gecht et al.), 6230214 (Liukkonen et al.), 6397261 (Eldridge et al.), and 6854641 (Takagi), U.S. Patent Application Publication numbers 2003/0002081 (Leone III et al.) and 2003/0011809 (Suzuki et al.), and World International Property Organization Publication number WO 01/42894 (Larsson et al.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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